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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,757	03/20/2006	Raul Hess	HESS-3	9549
20151 7590 03/18/2009 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER				
GARLAND, STEVEN R				
ART UNIT		PAPER NUMBER		
2121				
MAIL DATE		DELIVERY MODE		
03/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,757

Applicant(s)

HESS, RAUL

Examiner

STEVEN R. GARLAND

Art Unit

2121

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/19/08, 9/13/06, 3/20/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 6/19/08, 9/13/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 14-27 are pending. Claims 1-13 have been cancelled.
2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

3. The disclosure is objected to because of the following informalities: in numbered paragraph 0006 it appears the patent number "6,300,565" should be --6,300,595--, since 6,300,565 is directed to a controller for a motor vehicle.

Appropriate correction is required.

4. Remarks: regarding the claim language, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further functional and an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 14-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-48 of copending Application No. 10/572756 (published as 2006/0278613) in view of Williams 6,300,595.

For example comparing instant claim 14 to copending claim 25, both are directed to a process for removing material from a non-planar surface, both use a raster image to describe the surface, and both remove material layer by layer.

The instant claim however specifies that the removal agent removes material point-wise.

Williams 6,300,595 teaches the use of a laser to remove material point-wise.
Abstract , col. 1, lines 38-61.

It would have been obvious to one of ordinary skill in the art to modify the copending claim to use a laser to point-wise remove material and provide fine detail.

Similar comparisons can be made for the other claims.

This is a provisional obviousness-type double patenting rejection.

7. Claims 14-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-21 of copending Application No. 10/572,755 (published as 2007/0120842) in view of Williams 6300,595.

For example comparing instant claim 14 to copending claim 11, both are directed to a process for removing material from workpiece (surface) having an arbitrary three dimensional shape, both describe the surface using a raster image (polygons), both remove material in a point wise manner.

The instant claim however removes material layer by layer.

Williams teaches layer by layer of material using a laser. See the abstract.

It would have been obvious to one of ordinary skill in the art to modify the copending claim in view of Williams and remove the material layer by layer.

Similar comparisons can be made for the other claims.

This is a provisional obviousness-type double patenting rejection.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 14-16 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Williams 6,300,595.

In the following rejection the "non-planar" limitation in the preamble of claim 14 is given no weight, since the rest of the claim does not require it

Williams 6,300,595 teaches laser material removal of material using raster images (two dimensional maps) with the images associated with different gray levels. Williams also teaches the use of various types of paths including crosshatched (polygon) col. 5, lines 48--64. See the abstract; figures; col. 1, lines 11-17 and 38-62; col. 1, line 66 to col. 2, line 3; col. 2, lines 35-40; col. 3, line 38 to col. 4, line 21; col. 5, lines 48-64; and the claims.

If the preamble regarding "non-planar" is given weight then Williams teaches the use of the method to remove material from a workpiece (col. 1, lines 11-17 and col. 1, line 65 to col. 2, line 3; and the claims.

It would have been obvious to one of ordinary skill in the art to modify Williams in view of the teaching of Williams and apply the method to any shape of workpiece.

11. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams 6,300,595 in view of Giori 2004/0232108.

Williams 6,300,595 teaches laser material removal of material using raster images (two dimensional maps) with the images associated with different gray levels. Williams also teaches the use of various types of paths including crosshatched (polygon) col. 5, lines 48-64. See the abstract; figures; col. 1, lines 11-17 and 38-62; col. 1, line 66 to col. 2, line 3; col. 2, lines 35-40; col. 3, line 38 to col. 4, line 21; col. 5, lines 48-64; and the claims.

Williams however does not expressly state that pixels are used.

Giori 2004/0232108 teaches the use of pixels, raster patterns, use of a gray level of pixel to display its depth, and laser removal of material. See the abstract; figures; numbered paragraphs 0007, 0013, 0015, 0017, 0024, 0053, 0056, 0058, 0064 and the claims.

It would have been obvious to one of ordinary skill in the art to modify Williams in view of Giori to use pixels with gray levels so that the depth of material removal could be easily displayed on a computer screen.

12. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams 6,300,595 in view of Giori 2004/0232108 as applied to claims 17-22 above, and further in view of Aberle et al. 2002/0043522.

Williams 6,300,595 teaches laser material removal of material using raster images (two dimensional maps) with the images associated with different gray levels. Williams also teaches the use of various types of paths including crosshatched (polygon) col. 5, lines 48-64. See the abstract; figures; col. 1, lines 11-17 and 38-62;

col. 1, line 66 to col. 2, line 3; col. 2, lines 35-40; col. 3, line 38 to col. 4, line 21; col. 5, lines 48-64; and the claims.

Williams however does not expressly state that pixels are used.

Giori 2004/0232108 teaches the use of pixels, raster patterns, use of a gray level of pixel to display its depth, and laser removal of material. See the abstract; figures; numbered paragraphs 0007, 0013, 0015, 0017, 0024, 0053, 0056, 0058, 0064 and the claims.

It would have been obvious to one of ordinary skill in the art to modify Williams in view of Giori to use pixels with gray levels so that the depth of material removal could be easily displayed on a computer screen.

Williams while teaching removing material using cross hatched lines (polygons) does not expressly show crosshatched lines.

Aberle et al. 2002/0043522 teaches cross hatched lines in figure 3 and offsetting to prevent common edges. See the figures and numbered paragraphs 0009, 0016, 0018, and the claims.

It would have been obvious to one of ordinary skill in the art to implement the cross hatched lines of Williams and Giori by the polygons of Aberle and offsetting different layers.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN R. GARLAND whose telephone number is (571)272-3741. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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